

Application No. 09/223,347  
Response Dated July 19, 2004

### **REMARKS/ARGUMENTS**

Claims 51-70 are currently pending in this application. In the final Office Action mailed on May 19, 2004, the Examiner rejects claims 51-61 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,877,134 (Klein) in view of Japanese Patent Publication No. 08-3044140 (Susumu et al.) and a newly-cited item, U.S. Patent No. 6,180,351 (Cattell). The Examiner also rejects claims 62-70 under 35 U.S.C. §103(a) as being unpatentable over Klein '134 in view of Susumu et al. and Cattell '351 as applied to claims 51-61, and further in view of U.S. Patent No. 5,609,778 (Pulaski et al.).

According to the final Office Action, the Cattell '351 patent is relied upon by the Examiner for its disclosure of universally unique identifiers, such as bar codes, on biological arrays that are manufactured at a fabrication facility and shipped to the end user. However, the Applicants note that the filing date of the Cattell '351 patent is July 22, 1999, while the filing date of the present application is December 30, 1998. Under these circumstances, the Cattell '351 patent cannot constitute prior art against the present application under 35 U.S.C. §102(e) or under any other section of the patent statute. See M.P.E.P. §§901.04 and 2136. Since all of the outstanding claim rejections rely on the Cattell '351 patent, the Applicants believe that the rejections are improper and should be withdrawn.

The Examiner concedes in the final Office Action that the Klein '134 patent lacks any disclosure of a container information database, as well as any indication that the disclosed bar codes are universally unique. Both of these features, which are recited in Applicants' independent claim 51, are also absent from the Susumu et al. reference. Since the newly-cited Cattell '351 patent cannot be relied upon to supply the missing disclosure, the Applicants believe that independent claim 51 and dependent claims 52-70 are patentable over the prior art.

For the sake of completeness, the Applicants have reviewed U.S. Patent Nos. 5,812,793 and 5,404,523, the two patents which are cited in column 2 of the Cattell '351 patent for their

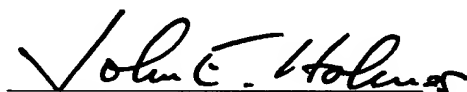
Application No. 09/223,347  
Response Dated July 19, 2004

disclosures of unique identifiers. Copies of these patents are being provided to the Examiner in a "Third Supplemental Information Disclosure Statement" which is being filed concurrently with this Response. As the Examiner will appreciate, the '793 and '523 patents disclose computer-related inventions which have nothing whatsoever to do with the identification of biological samples or with the marking of containers. Accordingly, they do not affect the patentability of the Applicants' invention as presently claimed.

The Applicants have discovered that the copy of Form PTO-1449 which accompanied the "Second Supplemental Information Disclosure Statement" filed on February 6, 2004 incorrectly identified the filing date of the present application. To the extent that this error led the Examiner to mistakenly view the Cattell '351 patent as having an early enough date to constitute prior art against the present application, the error is sincerely regretted.

In view of the foregoing remarks, it is believed that the present application is in condition for allowance and a formal notice to that effect is respectfully requested. Should the Examiner have any questions or wish to discuss this application with the Applicants' representative, she is invited to contact the undersigned attorney at the local telephone number listed below.

Respectfully submitted,



John E. Holmes  
Reg. No. 29,392  
Attorney for Applicants

Roylance, Abrams, Berdo & Goodman, L.L.P.  
1300 19<sup>th</sup> Street, N.W., Suite 600  
Washington, D.C. 20036  
(202) 659-9076

Dated: July 19, 2004